



Commissioner for Patents
P.O. Box 1450
Alexandra, VA 22313-1450
on January 22, 2007

Date of Deposit

John R. Lagowski

Name of applicant, assignee or
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John Lapach
Signature

Signature

January 22, 2007

Date of Signature

Our Case No. 10022/24

In re Application of:

Perry et al.

Serial No.: 09/746,611

Filing Date: December 21, 2000

For: Computerized Method for
Evaluating and Shaping a Business
Proposal

Examiner: C. Michelle Tarae

Group Art Unit No.: 3623

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

We request review of the final rejection of the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal.

REMARKS

Claims 1, 3, 4, 7, 8, 12-18, 22-26 and 28-58 are presently pending. Claims 1, 18, and 32 are independent. In the final Office Action of November 24, 2006, all pending claims were rejected under 35 U.S.C. §103(a) as unpatentable over Belcsak et al. (U.S. 6,957,191). We respectfully assert that it is clearly erroneous to conclude that teaching a finance tool having calculations for use in merger and acquisition finance operations, as Belcsak et al. does, teaches or suggests a method for selecting a type of business structure. Belcsak et al. does not provide even a hint of a motivation for a modification toward use to select a type of business structure. In sum, the final Office Action is not supported by a correct reading of Belcsak et al.

Belcsak et al. discloses "an automated tool for modeling the cash flows of financial scenarios . . ." col. 1, lines 15 and 16. The Belcsak et al. patent disclosure consists of (a) a description of a system (tool), (b) a description of an interface, and (c) examples of use. The primary examples of use, repeated throughout the specification, are for modeling a financial transaction between a lender and borrower, or between a lessor and lessee. The examples show how the tool and interface are designed to receive and implement different types of information to create a model of the terms of a financial agreement. See for example the "Qualified Telecommunications Equipment" case (lessor-lessee) from col. 19, line 1 to col. 25, line 34.

The main aspect of Belcsak et al. is discussed at col. 3, lines 36-44:

In accordance with a main aspect of the instant invention, a financial transaction modeling and analysis tool is provided which includes: a graphical user interface which enables a user of the tool to create a graphical model of a financial scenario, generally including at least one financial transaction, on a display screen; and an engine operable, in response to creation of the graphical model, to generate information which at least partially models at least a part of the financial scenario using information collected by the engine during creation of the graphical model.

At col. 3, lines 45-54, Belcsak et al. provides an overview of the graphical user interface, financial instruments, financial scenarios, instrument information, and parties to an instrument:

The graphical user interface preferably enables the user to create party graphics respectively representing parties to the financial scenario, and to generate financial instrument graphics representing financial instruments, wherein each financial instrument graphic connects two of the party graphics. The party graphics and the financial instrument graphics define the graphical model of the financial scenario. Preferably, the financial instrument graphics indicate a direction of flow, relative to the financial instrument represented thereby, between the parties connected by the financial instrument graphic.

Belcsak et al. discusses the tool and user interface in detail, often referring to the lender-borrower or lessor-lessee scenarios. Within 70 columns of disclosure, Belcsak et al. mentions “merger” and “acquisition” once:

*** The system also provides canned calculations for specific types of financial elements (e.g. rent, loans, etc.). These canned calculations cover a very large fraction of the payments users would run into when modeling a financial scenario. Thus, users will spend little time having to invent new payment mechanisms. In addition, this set of canned calculations is contained in an expandable library, so as the industry changes, additions can be added to the library to keep it up to date. *** In addition to general financial instruments, the system may also include instruments for advanced corporate finance operations, such as mergers, acquisitions and the like. Col. 11, lines 37 to 62. (underline added)

The reference to mergers and acquisitions in Belcsak et al. is to demonstrate that a library of calculations may include calculations that pertain to a corporate finance operation, such as an acquisition. For example, a finance operation for an acquisition may utilize a calculation from the library of calculations. It is important that this paragraph, specifically the last sentence, be understood correctly and in the context of the Belcsak et al. disclosure.

The paragraph does not teach or suggest selecting between a merger and an acquisition. Belcsak et al. never mentions that the tool is or can be used to select one business structure over another, such as a merger over an acquisition, and indeed provides no motivation to modify itself to obtain the claimed invention.

Referring now to the present application, the independent claims all include a “selecting” limitation. For example, the selecting limitation of claim 1 provides:

A method of preparing and evaluating a business proposal, comprising the steps of:

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*

selecting at least two alternative structures between a purchaser and a provider selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture . . .

Claim 1 thus includes selecting at least two structures from an alliance, an acquisition, an equity venture, a partnership, and a venture.

The final Office Action refers to Belcsak et al. at col. 1, lines 22-30 and states that “Belcsak et al. discloses that the invention is directed to a modeling tool that analyzes various aspects of a *proposed* financial arrangement between parties to the transaction and *structures* the financial proposals in an optimal manner.” (emphasis added in Office Action) Although the words “proposed” and “structures” are both italicized, they do not go together in the sense of “proposed structures.” Indeed, structures is used as a verb in the cited sentence. The *act of structuring* is not a structure, alliance, acquisition, etc. In addition, “proposed” refers to financial arrangements, not business structures. We respectfully assert that the reliance on col. 1, lines 22-30 to show a teaching or suggestion of selecting a business structure such as an alliance, acquisition, equity venture, partnership, and venture is clearly erroneous.

Next, the Office Action refers (in combination) to col. 4, lines 29-37 and col. 11, lines 59-62 and states that “a financial instrument is disclosed as encompassing advanced corporate finance operations . . .” We respectfully assert that combining these two sections does not provide the purported result and doing so is not in the context of Belcsak et al.

Belcsak et al. does not state that a financial instrument encompasses an advanced corporate finance operation. As discussed above, Belcsak et al. states that “the system may also include instruments **for** advanced corporate finance operations”. (emphasis added). No where, however, does Belcsak et al. state that mergers and acquisitions are financial instruments. We respectfully assert that the purported definition of “financial instrument” is clearly erroneous.

In addition, the Office Action refers to Figure 3 and states that a process is illustrated "in which a user has the option to add more instruments before creating the proposed financial model." Figure 3 shows that "Another Party or Instrument" can be added before a model is created. Figure 3 has nothing to do with selecting a structure selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture. We respectfully assert that Figure 3 does not teach or suggest selecting a business structure such as an alliance, acquisition, equity venture, partnership, and venture is clearly erroneous.

We note that independent claim 18 also recites a "selecting" step:

selecting at least two alternative structures . . . selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture

As does independent claim 32:

a computer program residing in said computer or in said memory, wherein the proposal [being evaluated] includes a plurality of alternative structures between a purchaser and a provider selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture

Accordingly, we respectfully assert that the rejections to the pending claims are based upon a clearly erroneous analysis of Belcsak et al. In addition, we assert that it would be clearly erroneous to conclude that Belcsak et al. teaches or suggest modifying itself for use to select a business structure. We request that these errors be reviewed, the rejections withdrawn, and the claims allowed.

Respectfully submitted,



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